

### **REMARKS**

The Non-Final Office Action mailed March 23, 2009 and the references cited therein have been carefully considered. Claim 1-16 are now pending in the application. By this Response, the Specification as well as Claims 1 and 14 are hereby amended in order to clarify that which Applicants regard as an aspect of the invention. Additionally, new dependent claims 17-20 have been added by this amendment. The Specification, as well as Claims 1 and 14, are amended to clarify that the “window-like” or “window-shaped” openings refer to a “through-hole” in support 1, as particularly shown in Fig. 2 of the drawings. Further support for the newly added Claims 17-20 can be found on page 13 of the specification, as well as Fig. 2, as well as more generally throughout the specification. Thus, no new matter has been added by amendments to the claims.

### **Interview Summary**

Applicants appreciate and respectfully acknowledge the telephone interview that took place between Examiner Robert Grabowski and Supervisory Examiner Dana Ross on June 2, 2009. During the interview, the interpretation of a “window-shaped opening” or simply “opening” was discussed, at which time Examiner Grabowski indicated that he considered a depression as taught by European Patent No. 1 398 174 to Moreau as being an opening. Thus, it was suggested at that time that the use of the language “through-hole” would more clearly distinguish an aperture passing through the substrate thickness and would be supported by the original disclosure as recited in the specification and more specifically shown in Figure 2 of the drawings. Examiner Grabowski acknowledged that amending the independent claims to recite a

through-hole would overcome the pending rejections of the claims based on Moreau, although he reserved the right to further consider additional prior art in view of an amendment in this regard. For example, Examiner Grabowski noted that U.S. Patent No. 6,036,230 to Farber discloses a through-hole in a substrate, although it was acknowledged that the particular configuration of the sealing layer of Figure 2 of the subject application was not disclosed by Farber. In concluding the interview, no formal agreement was reached.

#### **Claim Rejections under 35 USC §§102 and 103**

Claims 1, 2, 4, 5, 7 and 14-16 are rejected under 35 U.S.C. §102(b) as being anticipated by **Moreau**. Additionally, Claim 3 is rejected under 35 U.S.C. §103(a) as being unpatentable over Moreau. Further, Claim 6 and 8-13 are rejected under 35 U.S.C. §103 as being unpatentable over Moreau in view of U.S. Published Patent Application 2005/0040641 to **Cote et al.** In view of the amendments to the claims, as acknowledged during the above mentioned telephone interview, the pending claim rejections are rendered moot. Thus Applicants respectfully request reconsideration and withdrawal of the pending rejections of the claims herein.

Moreau discloses a banknote or security note 1 that includes a substrate having a zone 2 of reduced thickness in the substrate. On one or both sides of the note 1, a strip 3 of transparent material is placed over the zone 2 in order to reinforce that portion of the note 1 (see, Moreau paragraph [0022]). Moreau clearly does not disclose or suggest a through-hole in the substrate. Additionally, Moreau does not disclose that the sealing layer which is “applied to the side of the

support which is in opposite relationship to the film element” is “formed from a lacquer layer.”

Rather, Moreau discloses the use of a “strip” of material being applied to opposed face of the note (see, Moreau paragraph [0027]), but does disclose the material composition of the strip.

Thus, Moreau clearly fails to disclose or reasonably suggest all the elements of the claimed invention.

Additionally, while Cote et al. is cited for the teaching of a particular sealing layer materials and/or thicknesses, there is no disclosure or suggestion in Cote et al. to apply such a sealing layer or protective coating to a paper support having through-holes therein. It should be noted that in all the embodiments disclosed in Cote et al., the protective coating 24 is applied over a solid support 12 (see Cote et al, Figs. 9-12 and related disclosure). Thus, even a combination of Moreau and Cote et al. further fails to disclose or reasonably suggest all the elements of the claimed invention.

Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejections of the Claims under 35 U.S.C. §§102(b) and 103(a) based **Moreau** alone or in combination with **Cote et al.**

Further still, the Examiner has suggested, during the above mentioned interview, that the prior art, such as **Farber**, discloses a through-hole in a substrate, which might very well be combined with Moreau to arrive at the claimed invention. Applicants respectfully traverse and object to this suggestion as improper hindsight and merely using Applicants’ own invention as a roadmap to assemble various prior art references without a reason or suggestion in the prior art to

do so. Applicants' in the previous response already distinguished both the Farber and U.S. Published Patent Application No. 2005/0104364 to Keller et al. Both these references fail to disclose or reasonably suggest an optical security feature or a sealing layer comprising a lacquer layer. Thus, Applicants incorporate herein by reference those arguments previously presented and presumably considered persuasive to the Examiner in view of the new grounds of rejection presented in the subject Office Action.

Further, according to Farber and Keller, openings or through-holes in a paper substrate are closed on both sides by means of a film element. Using such an approach traps air, at least partially between the two film elements (See, Farber Fig. 4 or Keller Fig. 13). This construction provides an insufficient connection between the film elements in the areas of the edges of the paper substrate that surround or border the through-hole. In daily use, such a construction is subject to tiny cracks forming in one or both of the film elements so that moisture can migrate in between the two film elements. What is more, the entering moisture will have particular detrimental effects on the paper substrate, such as moisture expansion thereof and/or decreased adhesion of the foil element. Thus, portions of the foil elements subsequently become loose, substantially compromising and/or shortening the useful life of the valuable document. In contrast, aspects of the present invention close the through-hole in the paper support with a film element on one side, but with a lacquer layer on the opposed side. The lacquer layer thereby serves as a sealing layer for both the film element and the through-hole (as shown in Fig. 2 of the instant case). By reliably sealing both the edges of the through-hole as well as the surface of the film element, no air remains between the layers and thus subsequent moisture damage is avoided

(See, the instant Specification at page 13). Additionally, an advantage of this aspect of the invention is that even where cracks were to form in the film element or lacquer layer, any detrimental effects would be isolated to a very small in the vicinity of the crack. In contrast, the prior art construction would allow such moisture to spread inside the “air gaps” and particularly to the unsealed edges of the paper support. These aspects and advantages of the disclosed technologies of the subject application are not taught by the prior art.

In view of the foregoing remarks, Applicants respectfully request reconsideration and allowance of the claims presented.

### **Conclusion**

Applicants submit that the amended claims, particularly independent Claims 1 and 14 are clearly distinguished from the cited prior art references. Also, Claims 2-13 and 15-20 which ultimately depend from Claims 1 and 14 are similarly patentable over the art of record by virtue of their dependence. Also, Applicants submit that Claims 2-13 and 15-20 define patentable subject matter in their own right.

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In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration and allowance of the claims presented. If the Examiner has any questions or suggestions to expedite allowance of this application, he is cordially invited to contact Applicants' attorney at the telephone number provided.

Respectfully submitted,

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